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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,290	10/05/2001	Richard A. Holl	18925-31	6004

33717 7590 12/04/2003

GREENBERG TRAUIG LLP
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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 12/04/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,290

Applicant(s)

HOLL ET AL.

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4/8. 6) ☐ Other: _____

DETAILED ACTION

Response to Election

1. This action is in response to the provisional election mailed September 17, 2003.
(Group II) Claims 14-21 were provisionally elected rendering (Group I) Claims 1-13 to a non-elected species.

RESPONSE TO REQUEST FOR RECONSIDERATION

2. Applicant's election with traverse of (Group II) is acknowledged. The traversal is on the ground(s) that "the intertwined relationship between the claims of Group I and Group II... will necessarily encompass the search of the claims of Group I, since the claims of Group I are drawn to the method for producing composites of fine powdered fillers of Group II, which may be disclosed in references that relate to the articles consisting of bodies of composite materials of Group II" is not persuasive. The search of the 2 classes and subclasses would entail the requisite serious burden as the search for method of making is not the same as the article search. The possibility of double patenting would not become an issue because Obvious Double Patenting is not permitted after a restriction requirement is made stating the two groups are patentably distinct. Additionally, the steps used in the method claims would not be expected to appear in the class/subclass of the product claims. Every article consisting of finely powdered material is not made the same.

The requirement is deemed proper and is therefore made **FINAL**.

NONSTATUTORY DOUBLE PATENTING

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 14-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 30-50 of Holl et al. (U.S. Patent No. 6,159,264). Although the conflicting claims are not identical, they are not patentably distinct from each other because they both include composite materials comprising finely powdered filler material distributed in a polymer matrix, comprising the balance polymer, wherein the melted polymer is dispersed substantially uniformly into the interstices between the particles of the filler material. Although Holl et al. does not specifically disclose a stack from 6 to 120 thin coherent layers, different numbers of the same layer does not lend patentability. Mere duplication of essential working parts involves only routine skill in the art.

NONSTATUTORY DOUBLE PATENTING

5. Claims 14-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 30-50 of Holl et al. (U.S. 6,391,082). Although the conflicting claims are not identical, they are not patentably distinct from each other because they both include composite materials comprising finely powdered filler material distributed in a polymer matrix, comprising the balance polymer, wherein the melted polymer is dispersed substantially uniformly into the interstices between the particles of the filler material. Although Holl et al. does not specifically disclose a stack from 6 to 120 thin coherent layers, different numbers of the same layer does not lend patentability. Mere duplication of essential working parts involves only routine skill in the art.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. London et al. (U.S. 5,100,736) discloses a polymer-reinforced matrix composite (abstract). Additionally, Pratt et al. (U.S. 4,732,818) discloses a composite comprising a metal matrix (claim 1).

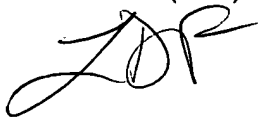
Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM

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– 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISOR, EXAMINER
TECHNOLOGY SECTION 1774

